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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,829	01/11/2001	Koichiro Yamaguchi	NAK1-BN62	8528
21611	7590	02/03/2005	EXAMINER	
SNELL & WILMER LLP 1920 MAIN STREET SUITE 1200 IRVINE, CA 92614-7230			BUI, KIEU OANH T	
			ART UNIT	PAPER NUMBER
			2611	
DATE MAILED: 02/03/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,829

Applicant(s)

YAMAGUCHI ET AL.

Examiner

KIEU-OANH T BUI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1-2</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As for claim 3-6 and 12-13, the step of “wherein the interactive data contains a plurality of sets of presentation data and link information which associates each of the plurality of sets of presentation data with a link to a set of presentation data”, wherein one of the plurality of sets of presentation data is currently presented, wherein the restricting means includes: user input receiving means for receiving a user operation relating to the presented set of presentation data: link means for (a) specifying, based on the received user operation, a set of presentation data that is a link destination of a link associated by the link information with the presented set of presentation data if either the preview state or the prohibited state is judged as being established, (b) judging whether the specified set of presentation data and the presented set of presentation data are included in a same group, (c) obtaining the specified set of presentation data on judging that the specified set of presentation data and the presented set of presentation data are included in the same group, and (d) restricting use of interactive data relating to the received user operation on judging that the specified set of presentation data and the presented set of

presentation data are not included in the same group; and presenting means for presenting the obtained set of presentation data.

These claims are vague and indefinite in terms of English language, the Examiner is not sure to what and how “the presentation data and link information” associates to what type of data, to itself or to what identity; and based on the presentation format as a semicolon after the restricting means, the Examiner also is not sure whether all the rest of the limitations are under the restricting means or not.

Claims 7-9 and 10-11 have the same issue as of claim 3 for the steps of “a plurality of sets of presentation data; a link information which associates each of the plurality of sets of presentation data with a link to a set of presentation data” as discussed above.

Applicants are required to correct, modify and explain these types of issues to avoid the claim languages as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

4. Claims 1-2, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hendricks et al. (U.S. Patent No. 5,734,853).

Regarding claim 1, Hendricks discloses “a digital broadcast receiving device that receives a broadcast wave including interactive data to achieve pseudo-interactive communications, the interactive data being repeatedly broadcasted”, (i.e., a digital set top terminal receives broadcasting signals for interactive communications between the set top terminal and the broadcasting source via a cable headend (Figs. 1-3, and col. 3/lines 20-55)), the digital broadcast receiving device comprising:

“receiving means for receiving the broadcast wave” (Fig. 5a for internal structure of the set top receiving device, and tuner 603 for receiving cableTV input and modem 627 for communications between the set top terminal and the cable headend, see col. 19/lines 7-42);

“judging means for judging a state that is established during the reception of the broadcast wave based on first information, the state being one of a preview state, a prohibited state, and a permitted state, wherein the first information shows conditions for using the received broadcast wave under a subscription contract, wherein in the preview state, the received broadcast wave is permitted to be used regardless of the subscription contract being made, and wherein in the prohibited state, the broadcast wave is prohibited from being used because the subscription contract is not made; and restricting means for restricting use of the interactive data when either the preview state or the prohibited state is judged as being established”, (i.e., all of the judging means to determine whether a user is a subscriber or not, namely, the subscription contract is being made or not, so that the system can either grant the access or deny the access and even limit the access as described in diagrams in Figures 12a-12f , col. 29/line 49 to col. 32/line 18; and Fig. 17 clearly shows that the viewer can preview a program, at this time, the viewer is just browsing through a list of hit movies as shown in Fig. 16 and as he chooses Terminator 4, he has

a chance to preview the program regardless of the subscription contract being made or not, as soon as he pays the charge for the program, a “Thank you” screen is displaying and he can join in (a subscription contract is already made) and enjoy the movie as shown in Fig. 18, and col. 35/line 37 to col. 36/line 29; the system limits or restricts the user’s access if the subscription contract is not being made, and the program list is redisplaying to the user again (col. 28/lines 41-52)).

For claim 2, in view of claim 1, Hendricks further discloses “wherein the broadcast wave also includes second information which shows conditions for using the broadcast wave, wherein the first information is recorded on a recording medium”, (i.e., as shown in Figs. 4a and 4b, the broadcast control information contains a format as shown in Fig. 4a --as a second information -- and Fig. 4b shows a similar format stored within the set top terminal including identifiers of the set top terminal—as the first information-- and others (col. 17/line 24 to col. 18/line 11)), “wherein the judging means includes: obtaining means for obtaining the first information from the recording medium; contract judging means for judging whether the first information and the second information are the same, determining that the subscription contract is made on judging that the first and second information are the same, and determining that the subscription contract is not made on judging that the first and second information are not the same”, (i.e., this process is the authentication process for the user between the system and the set top terminal, the matching of identifiers for each set top terminal is monitoring and verified by the system as in the formats of Figure 4a & 4b as noted, see col. 18/lines 5-51)); and

“preview state judging means for (a) judging whether a predetermined period has passed since a start of the reception of the broadcast wave if the contract judging means determines that the subscription contract is made” (the preview has a predetermined time, and if the payment has made, the preview has passed after a predetermined time (col. 28/line 54-67 for a message with the preview time left),

“(b) determining that the preview state is established during the reception on judging that the predetermined period has not passed” (Fig. 12e and col. 31/lines 30-45 for a routine in determining whether a preview time has passed or not), and

“(c) determining that the prohibited state is established during the reception on judging that the predetermined period has already passed”, (i.e., if after the preview time is passed and the viewer has not made the purchase, the system automatically prohibits the viewer to view the interest program and brings the viewer back to the menu of program list (col. 28/lines 41-52)).

Regarding claim 14, Hendricks discloses “a digital broadcast system, comprising: a digital broadcast sending device that broadcasts a broadcast wave containing interactive data, the interactive data being repeatedly broadcasted; and a digital broadcast receiving device that receives the broadcast wave to achieve pseudo-interactive communications, the interactive data being repeatedly broadcasted, wherein the digital broadcast receiving device includes: receiving means for receiving the broadcast wave; judging means for judging a state that is established during the reception of the broadcast wave based on first information, the state being one of a preview state, a prohibited state, and a permitted state, wherein the first information shows conditions for using the received broadcast wave under a subscription contract, wherein in the preview state, the received broadcast wave is permitted to be used regardless of the subscription

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contract being made, and wherein in the prohibited state, the broadcast wave is prohibited from being used because the subscription contract is not made; and restricting means for restricting use of the interactive data when either the preview state or the prohibited state is judged as being established”, (i.e., a digital set top terminal receives broadcasting signals for interactive communications between the set top terminal and the broadcasting source via a cable headend (Figs. 1-3, and col. 3/lines 20-55); Fig. 5a for internal structure of the set top receiving device, and tuner 603 for receiving cable TV input and modem 627 for communications between the set top terminal and the cable headend, see col. 19/lines 7-42; and all of the judging means to determine whether a user is a subscriber or not, namely, the subscription contract is being made or not, so that the system can either grant the access or deny the access and even limit the access as described in diagrams in Figures 12a-12f, col. 29/line 49 to col. 32/line 18; and Fig. 17 clearly shows that the viewer can preview a program, at this time, the viewer is just browsing through a list of hit movies as shown in Fig. 16 and as he chooses Terminator 4, he has a chance to preview the program regardless of the subscription contract being made or not, as soon as he pays the charge for the program, a “Thank you” screen is displaying and he can join in (a subscription contract is already made) and enjoy the movie as shown in Fig. 18, and col. 35/line 37 to col. 36/line 29; the system limits or restricts the user’s access if the subscription contract is not being made, and the program list is redisplaying to the user again (col. 28/lines 41-52).

As for claims 15-16, these claims for “a receiving method used by a digital broadcast receiving device” and “a computer-readable recording medium storing a program used by a digital broadcast receiving device” with same limitations as disclosed earlier are rejected for the reasons given in the scope of claims 1-2 as explained in details above.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Strauss et al. (US. Pat. No. 5,790,173) and Lightfoot et al. (US. Pat. No. 5,583,864) disclose advanced digital networks for providing the communication between subscriber's terminals and broadband server's equipment.

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park F.F. 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant, can be reached on (703) 305-4755.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Krista Bui
Art Unit 2611
January 26, 2005


KRISTA BUI
PATENT EXAMINER